

REMARKS/ARGUMENTS

Claims 1-5, 7-15, 17, 18 and 20-23 were pending in this application. Claims 1, 9, and 18 have been amended. Claims 8, 10, and 20 have been canceled. No claims have been added. Hence, claims 1-5, 7, 9, 11-15, 17, 18, and 21-23 remain pending after entry of the amendments herein. Reconsideration of the subject application as amended is respectfully requested.

Claims 1-5, 7-15, 17, 18 and 20-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of the cited portions of U.S. Patent No. 6,397,194 to Houvener et al. (hereinafter "Houvener"), and further in view of the cited portions of U.S. Publication No. 2001/0029470 A1 to Schultz et al. (hereinafter "Schultz").

Claims 1 and 18 have been amended to more distinctly recite the Applicant's claimed invention, the support for which may be found at, for example, paragraphs 35-37 of the Applicant's specification. No new matter has been added. Claim 9 has been amended to reference claim 1 instead of claim 8, now canceled.

Claims Rejections Under 35 U.S.C. § 103(a)

Independent claims 1 and 18, as amended, include subject matter not taught or suggested by the cited references. For example, claim 1 includes, "receiving information from the consumer computer that defines at least one category based on product information ... and transmitting a second electronic file from the host computer system to the consumer computer, wherein the file comprises a listing of the items sorted into categories that include the at least one category based on product information for display at the consumer computer."

Similar limitations were examined at, for example, claim 10. In rejecting claim 10, the final office action cited paragraphs 37, 40, 58, and 67 of Schultz. Schultz, however, does not teach the limitations. At the cited locations, Schultz teaches a receipt organizer that allows the user to sort and categorize receipts, among other things. The teaching most relevant to the claimed invention is found at paragraph 67. At that location Schultz teaches a web page at which the user may categorize individual transactions into categories. In some cases, the user is able to name the category. This is different, however, from allowing user-definable categories into

which the host computer system sorts purchased items based on product information. In one case, the user must address each transaction individually. In the other, the user defines a category and purchased items are sorted into the categories based on the user's definition. Hence, claim 1 is believed to be allowable, at least for this reason. Claim 18 includes a similar limitation and is believed to be allowable at least for similar reasons.

The Applicant respectfully traverses the rejections of claims 11 and 21 since a skilled artisan would not be motivated to combine the references and the references, when combined, would not result in a working embodiment of the Applicant's claimed invention. As to the motivation, the office action appears to allege that one would have been motivated to combine the references to achieve the benefit of "being able to obtain more transactional information about the products/services they purchased in a timely manner without having to save their paper receipts." This fails to teach or suggest why one would include the teachings of Schultz, since the invention of Schultz has nothing to do with paper receipts (see, for example, the Abstract, and paragraphs 3, 10, 29, and 31, among others, of Schultz). Hence, the alleged motivation fails to explain why a skilled artisan would be motivated to combine these specific two references. Claims 11 and 21 are, therefore, believed to be allowable, at least for this reason.

Moreover, even if the alleged motivation amounts to sufficient motivation to combine these two particular references (which it does not), the office action does not provide a citation to the motivation in the prior art. The motivation appears to be based on the Examiner's personal knowledge, since no reference is cited. As such, the Applicant respectfully traverses the rejection and requests an express showing of documentary proof, or an affidavit, to which the Applicant is entitled (See, 37 CFR §1.104(d)(2)). It is not enough for the Examiner to simply assert that one of ordinary skill in the art would have been so motivated; the Examiner must produce documentation that one of ordinary skill in the art would have been so motivated. Lacking this, claims 11 and 21 are believed to be allowable for this additional reason.

Further, even if the alleged motivation were proper (which it is not) and even if a citation to the reference is available in the prior art (which has not been provided), the cited references could not be successfully combined to produce a working embodiment of the

Application No. 10/615,582
Amendment dated January 9, 2006
Reply to Final Office Action of August 31, 2005
and Advisory Action of December 9, 2005

PATENT

Applicant's claimed invention. Houvener teaches away from Schultz since Houvener requires paper receipts (see Houvener, col. 6, ll. 59, 60) and Schultz deals exclusively with electronic environments (see, for example, the Abstract, and paragraphs 3, 10, 29, and 31, among others, of Schultz). There is no receipt generated by Schultz to be scanned by Houvener. Hence, claims 11 and 21 are believed to be allowable, at least for this additional reason.

The remaining claims depend from one of the independent claims discussed above and are believed to be allowable, at least for the reasons stated above.

Conclusion

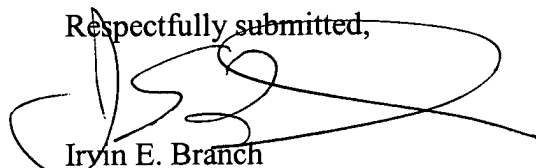
In view of the foregoing, the Applicant believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Date:

1/9/2006

Respectfully submitted,



Irvin E. Branch
Reg. No. 42,358

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, CA 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
IEB/jln
60669149 v1